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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,561	08/25/1999	ANDREW D. SUTTON	263742002800	5378

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

22

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-22

Office Action Summary

Application No.

09/382,561

Applicant(s)

SUTTON ET AL

Examiner

LOVERING

Group Art Unit

1712

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on DEC. 18, 2002

☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 20-25, 28, 29, 31-34 AND 37-44 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20, 22-25, 28, 29, 39 AND 41-44 is/are rejected.

☒ Claim(s) 21, 31-34, 37, 38 AND 40 is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved ☐ disapproved ☐.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some* ☐ None ☐ of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s) _____ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

Art Unit 1712

1. The indicated allowability of claims 20, 22-25 and 31-34 is withdrawn in view of the newly discovered reference(s) to Platz et al. 6,509,006. Rejections based on the newly cited reference(s) follow.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 20, 22-25, 28, 29, 39 and 41-44 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated or at least anticipated by Platz et al. 6,509,006, esp. Examples I-XII, and noting also column 4, lines 46-63; and column 6, lines 1-13. As to claims 24 and 44 herein, while Platz et al. don't use the term "sterile", one of ordinary skill in the art would infer that their biocompatible particles are sterile from column 11, lines 21-26. A reference need not disclose a specific limitation in haec verba. See In re Bode et al., 193 USPQ 12, 13; and Ex parte Novitski, 26 USPQ 2d 1389.

4. Applicant's arguments with respect to claim 29, etc. have been considered but are deemed to be moot in view of the new grounds of rejection.

Art Unit 1712

5. Claims 21, 31-34, 37, 38 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, including Platz et al. above, doesn't disclose or fairly suggest the therapeutic or diagnostic compositions of claims 21, 31-34, 37, 38 and 40 herein which require that the therapeutic or diagnostic agent be the sole component of the microcapsule.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
February 13, 2003

Richard D. Lovering
RICHARD D. LOVERING
PATENT EXAMINER
GROUP 1700